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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,310	06/23/2003	Masaki Hashimura	T36-156800M/RS	7969
21254	7590	11/25/2005	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			LE, DUNG ANH	
			ART UNIT	PAPER NUMBER
			2818	

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,310

Applicant(s)

HASHIMURA ET AL.

Examiner

DUNG A. LE

Art Unit

2818

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 12-26 is/are allowed.
- 6) ☒ Claim(s) 7 and 10 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The previous office action has been withdrawn. This is a new ground of rejection.

Oath/Declaration

The oath/declaration filed on 6/23/2003 is acceptable.

Information Disclosure Statement

This office acknowledges of the following items from the Applicant:

Information Disclosure Statement (IDS) filed on 6/23/2003 and 5/4/2005 and made of record . The references cited on the PTOL 1449 form have been considered.

Specification

The specification has been checked to the extent necessary to determine the presence of all possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

The drawings are objected to for the following reasons.

Figures 26A-26B, 27A- 27C, 28, 29, 30A-30B and 31 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP

§ 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Set of claims 7-11

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 7 is rejected under 35 USC 102 (e) as being anticipated by Sadaki et al. (6294439 B1).

Sadaki et al. teach a method of producing a plurality of semiconductor elements by individually dividing semiconductor elements formed on a substrate, said method comprising: performing a polishing or blasting process (col 1, lines 35- 40) with respect

to separation grooves 22 (figs. 8- 9) after forming said separation grooves by laser beam irradiation (col 1, lines 35- 45, col 9, lines 4-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Sadaki et al. (6294439 B1) in view of the following remark.

Sadaki et al. disclose the claimed invention substrate is made of glass as applied to claim 7, except for substrate is a sapphire substrate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize sapphire substrate because sapphire is commonly used to prevent undesirable reactions in the contact region, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the desired application.

Reasons for Indication of Allowable Subject Matter

Claims 8- 9 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, since the prior made of record and considered pertinent to the applicant's disclosure does not teach or suggest the claimed limitations. Sasaki et al. (U.S. Patent No. 6294439 B1) and Background of Invention, taken individually or in combination, do not teach the claimed invention having **(Regarding claim 8)** separation groove; are formed in a rear surface of said substrate opposite to a front surface of said substrate on which semiconductor layers and electrodes are formed; and said polishing or blasting process is applied to said rear surface; **(Regarding claim 9)** blasting process is used, particles used in said blasting process are selected so that a medium value of diameters of said particles is equal to about a half width of each separation groove, **(Regarding claim 11)** blasting process is used, particles used in said blasting process are mainly of alumina or silicon carbide.

Sets of Claims 1- 6, 12- 18 and 19- 26 would be allowed. Claims 1-6, 12- 18 and 19-26 are considered allowable since the prior made of record and considered pertinent to the applicant's disclosure does not teach or suggest the claimed limitations. Sasaki et al. (U.S. Patent No. 6294439 B1) and Background of Invention, taken individually or in combination, do not teach the claimed invention having **(Regarding claim 1)** the steps of scanning said substrate with a laser beam along said parting lines to

form separation grooves in a front surface of said substrate; and removing said protective film and unnecessary products produced by said laser beam scanning, wherein said separation grooves formed along said parting lines by said laser beam scanning are used for dividing said substrate into individual semiconductor elements; **(Regarding claim 12)** the step of scanning said substrate along said parting lines with a laser beam to thereby form broken line-shaped or dot line-shaped separation grooves, wherein said broken line-shaped or dot line-shaped separation grooves formed by laser beam scanning along the parting lines are used so that said substrate is divided into individual semiconductor elements and **(Regarding claim 19)** step of applying a laser beam on a metal layer formed on said semiconductor wafer and serving as a negative electrode of each of said semiconductor elements to thereby form continuous line-shaped, dot line-shaped, broken line-shaped or cross-shaped separation grooves for separating said semiconductor wafer into said plurality of semiconductor elements.

When responding to the office action, Applicants' are advice to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist the examiner to locate the appropriate paragraphs.


A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) day from the day of this letter. Failure to respond within the period for response will cause the application to become abandoned (see M.P.E.P 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung A. Le whose telephone number is (571) 272-1784. The examiner can normally be reached on Monday-Tuesday and Thursday 6:00am- 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms can be reached on (571) 272-1787. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DUNG A. LE 
Primary Examiner
Art Unit 2818